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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/737,697

12/14/2000

Thomas H. Slaight

075635.0113

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46629 7590 07/28/2008

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EXAMINER

AKINTOLA, OLABODE

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

07/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOmail2@bakerbotts.com

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Office Action Summary	Application No. 09/737,697	Applicant(s) SLAIGHT ET AL.	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Prosecution on the merits of this application is reopened after the Decision by the Patent Boar of Appeals and Interferences decided on March 26, 2008 on claims 1-32. These claims are considered unpatentable for the reasons indicated below: New art has been found.

The objections and rejections are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non- final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Status of Claims

Claims 1-32 remains pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 5-7, 10-12, 14-18, 20-22, 23-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kinney, Jr. et al (US 7249085).

Re claims 1,11 and 25: Kinney teaches a method (and corresponding system and readable medium) of conducting an on-line auction, comprising: receiving bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product (col. 4, lines 16-36; col. 5, lines 19-33), calculating, using a computer, the total cost of the at least one

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product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product (col. 5, lines 50-53; col. 6, lines 6-13 “ ‘x’ representing price parameter and ‘a’ representing non-price parameter”; col. 7, lines 41-47), and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser (col. 6, lines 11-13, 24-27, “ ‘y’ refers to bid parameter resulting from the transformation process, upon which the buyer will compare competing bids” ; col. 7, line 57 through col. 8, line 3).

Re claims 2, 18 and 26: Kenney teaches defining a plurality of parameters for a category of products; and defining a total cost formula for the category of products in response to the plurality of parameters (col. 8, lines 4-55; “BTU/lb, %sulfur, %ash”, “cost per unit of thermal content, cost per unit of electrical output”).

Re claims 3, 16-17 and 27: Kinney teaches wherein the total cost formula includes at least one constant associated with at least one parameter (col. 5, lines 50-53; col. 6, lines 6-13; col. 9, lines 54-55, parameter “x” representing price is constant).

Re claim 28: Kinney teaches wherein the plurality of parameters includes price and non price parameters (col. 4, lines 16-36; col. 5, lines 19-33).

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Re claim 29: Kinney teaches wherein the price parameters include at least one of a base price, volume discounts, rebates, life cycle discounts, utilization charges, maintenance charges and administration charges (col. 5, lines 50-53; col. 6, lines 6-13).

Re claims 12 and 30: Kinney teaches wherein the non-price parameters include at least one of delivery timing, national service coverage, minimum quality levels, employee skill levels, a dedicated account management team, special reporting requirements, online ordering, warranty and length of contract (col. 5, lines 19-33; col. 8, line 66 through col. 9, line 6, "*reputation of the supplier, etc*" and "*delivery time, etc*").

Re claim 31: Kinney teaches wherein defining a plurality of parameters comprises defining at least two sub-categories for the category of products, and defining at least two parameters for each subcategory (col. 8, lines 4-55).

Re claims 6-7, 14 and 32: Kinney teaches communicating the best vendor's bid to the other vendors to encourage competitive bidding (col. 9, lines 21-27).

Re claims 5 and 15: Kinney teaches enabling a purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by calculating means to determine the total cost of the product to the purchaser (col. 7, lines 32-34, col. 9, lines 30-34).

Re claim 10: Kinney teaches means for setting up the bidding on the product (Fig. 1 and 4)

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Re claim 20: Kinney teaches wherein bids from vendors are received through an Internet (abstract, col. 3, lines 56-60).

Re claims 21-22: Kinney teaches providing a vendor or purchaser with data about the status of an auction while the auction is in progress (Figs. 6A-6C).

Re claim 24: Kinney teaches allowing a total cost formula to be defined for each product in an auction (col. 6, lines 6-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney.

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Re claim 19: Kinney does not explicitly teach wherein the auction results take into account vendors bid on a market basket of products. Official notice is hereby taken that this feature is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature so that the purchaser can buy multiple products from the same vendor to take advantage of volume discount and/or shipping costs associated with purchasing individual items from various vendors.

Claims 4, 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Fisher et al (US 5835896).

Re claims 4, 8 and 13: Kinney further teaches communicating a vendor total cost to the vendors and that the invention can be applied in the context of upward based auction (Figs. 6B and 6C; col. 5, lines 56-59). Kinney does not explicitly teach this feature without revealing the identification of the vendor; and enabling messages to be sent to the vendor regarding status of bidding, ending time for the bidding and extension of the bidding. Fisher, in the same field of art, teaches these concepts and features at Fig. 2, col. 6, lines 31-58. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include these features as taught by Fisher for the obvious reason of updating the vendors about the status of the bids.

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Spiegelhoff et al (US 5402336).

Re claim 9: Kinney does not explicitly teach for calculating an amount of savings for the purchaser and means for communicating the savings to the purchaser. Spiegelhoff teaches this concept at col. 13, lines 33-36. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature as taught by Spiegelhoff for the obvious reason of identifying the best bid in terms of savings.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinney in view of Zawadzki et al (US 7107268).

Re claim 23: Kinney does not explicitly teach controlling which vendors are allowed to participate in an auction. Zawadzki teaches this concept at col. 53, lines 6-20. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinney to include this feature as taught by Zawadzki for the obvious reason of restricting participant to the auction.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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